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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,676	01/11/2002	Bernd Klinksiek	Mo6885/LeA 33,410	9095

157 7590 06/02/2004

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EXAMINER	
SERGENT, RABON A	

ART UNIT	PAPER NUMBER
1711	

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/030,676	KLINKSIEK ET AL.	
	Examiner	Art Unit	
	Rabon Sergent	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 6-9 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 6-9 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 6-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 37-40 of copending Application No. 10/030,927. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims is drawn to a process for the production of an aqueous dispersion, wherein the components of the dispersion are forced through an equivalent dispersing device.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahl et al. ('518) further in view of GB 997,974 in combination with Kasaya et al. ('178) and Kalsi ('320).

Kahl et al. disclose the production of an aqueous coating composition comprising a polyisocyanate and an isocyanate-reactive component, wherein the composition is produced by forcing the aqueous mixture through a jet disperser at a pressure of 1 to 30 MPa. See abstract. Furthermore, Kahl et al. disclose that the jet disperser has features pertaining to the adjustability of the disperser, variable throughput, and the ability of the bores or slots to be opened electrically. See column 5, lines 12-30 and figure 6. Referring to figure 6, the manipulation of

element 53 controls the opening and closing of the holes and, as a result, causes the jet disperser to be adjustable and to have variable throughput.

5. While Kahl et al. disclose jet dispersers having features corresponding to those of the claimed jet disperser, Kahl et al. fail to disclose jet dispersers which exactly correspond to those claimed; however, jet dispersers having the claimed pipe, sleeve, and piston arrangement were known at the time of invention and were further known to be useful for the production of dispersions and emulsions having finely dispersed components. This position is supported by the teachings of GB 997,974 (see pages 2 and 3 and figure 2). Furthermore, though GB 997,974 is silent regarding such features as pneumatic control and the use of ceramic materials, these features were nonetheless known for use within valves at the time of invention. Kalsi disclose the use of pneumatic operators to control flow through valves and Kasaya et al. disclose at columns 3 and 4 the use of ceramic materials for the surfaces of valve components. Kasaya et al. further disclose that the use of ceramic materials is beneficial, because they provide abrasion resistance.

6. Therefore, since dispersers having the claimed pipe, sleeve, and piston arrangement were known at the time of invention to be useful for the production of fine dispersions, and since analogous disperser were known to be useful for the production of aqueous polyurethane dispersions, the position is taken that it would have been obvious to produce the dispersions of Kahl et al. using the disperser of GB 997,974. The position is further taken in view of the teachings of Kahl et al. at column 5, lines 29 and 30, Kalsi, and Kasaya et al. that it would have been obvious to modify the disperser of GB 997,974 to be electrically or pneumatically

controlled, so as to promote automation and precision of control, and to utilize ceramic materials, so as to extend service life and promote ease of cleaning.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

RABON SERGENT
PRIMARY EXAMINER

R. Sergent
May 31, 2004